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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,047	03/31/2004	Richard A. Forand	80107.183US1	6169
7590 LeMoine Patent Services, PLLC c/o PortfolioIP P.O.Box 52050 Minneapolis, MN 55402			EXAMINER HO, DUC CHI	
			ART UNIT 2619	PAPER NUMBER
			MAIL DATE 03/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,047

Applicant(s)

FORAND ET AL.

Examiner

Duc C. Ho

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-18, 23-25 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-18, 23-25 and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 36-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 36, the claimed subject matter “a medium to hold machine-accessible instruction that when accessed result in a machine performing:” is directed toward a software program per se. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process. In context, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.

Applicant is suggested to follow the suggested formats below to avoid a rejection under 35 U.S.C. 101:

Examples of acceptable language in computer-processing related claims:

- I. "computer readable medium" encoded with _____
 - [a] "a computer program"
 - [b] "software"
 - [c] "computer executable instructions"
 - [d] "instructions capable of being executed by a computer"
- II. "a computer readable medium" _____ "computer program"

- [a] storing a
- [b] embodied with a
- [c] encoded with a
- [d] having a stored
- [e] having an encoded

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7, 8, 12-18, 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite. It is impossible to ascertain the scope of claim 1, i.e., it is unclear as to what kind of "information" and/or device will the notebook synchronize its "information in a personal information manager" with? The same remark applies to claim 23.

Claim 8 is indefinite. The limitation "synchronizing information in a personal information manager" in line 6 does not correlate with other limitations.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ovava (US 6,829,288) in view of Loughran et al.(US2002/0129107), hereinafter referred to as Loughran.

Regarding claim 30, Orava discloses communication system having wireless devices supporting AD HOC connection independent of the protocol version. In Orava, since Bluetooth (corresponding to WPAN) operates in short range communication, a user could automatically receive E-mail on his notebook or laptop computers while having a cellular phone in his pocket, see col. 3, lines 27-67.

Orava, however, does not expressly disclose the download of e-mail via a network other than WPAN.

One skill in the art would recognize the advantage of having a Bluetooth-enabled device such as a cellular phone, a PDA, etc. connects to a laptop computer so that the laptop could remotely initiate a download of e-mail from an e-mail server whenever it is notified.

Longhran discloses method and apparatus for automatic content handling. In Longhran a mobile computing device could be in the form of a cellular phone, or a laptop computer, and the alert module associated with the computing device would pass the connection and download instructions to the laptop CPU, i.e. receiving a SMS message containing an "EMAIL" header, power up the notebook, and the laptop would then dial the ISP, connect to the mail-server and download the email, see col. 3, paragraph 0004-0008, and 0039-0042.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Orava with Longhran.

The suggestion/motivation for doing so would have been to provide the laptop a way to remotely initiate a download of e-mail from an e-mail server whenever it is notified or requested.

Therefore, it would have been obvious to combine Orava with Longhran to obtain the invention as specified in claim 30.

Regarding claim 31, Orava discloses a wireless local area network.

Regarding claim 32, Longhran discloses a GSM cellular communications network which is also a WAN.

Regarding claim 33, this claim has similar limitations as claim 30. Therefore, it is rejected under Orava-Longhran for the same reasons set forth in the rejection of claim 30. The cellular phone of Orava receives a notification or a request to receive e-mail from a device of another network, i.e. e-mail server, the cellular phone communicates with the laptop for downloading e-mail.

Regarding claim 34, in Orava the request or a notification of e-mail could come from a corporate network.

Regarding claim 35, the cellular phone of Orava could connect to a corporate network using cached credentials.

Regarding claim 36, this claim has similar limitations as claim 30. Therefore, it is rejected under Orava-Longhran for the same reasons set forth in the rejection of claim 30. The laptop of Longhran includes computer executed instructions for downloading e-mail over a network other than the WPAN or Bluetooth short range communication.

Regarding claim 37, the cellular phone of Orava could connect to a corporate network using cached credentials.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 272-2988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2619

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

/Duc C Ho/

Primary Examiner, Art Unit 2619

03-10-08